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| 10/824,298      | 04/14/2004  | Haimanot Bekele      | 9211M               | 6061             |

27752 7590 11/02/2007  
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| EXAMINER |
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PAGONAKIS, ANNA

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| ART UNIT | PAPER NUMBER |
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4173

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11/02/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/824,298

**Applicant(s)**

BEKELE ET AL.

**Examiner**

Anna Pagonakis

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 14 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 12-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 16-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3 sheets.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

*DETAILED ACTION*

Applicant's election of Group I, claims 1-11, 16 and 17 in the reply received on 08/14/2007 is acknowledged. The traversal is on the grounds that the invention groups are closely related and would require common areas of search and consideration. This is not found persuasive because the claimed inventions are distinct. The claims of Group I are directed to a cosmetic composition, whereas the claims of Group II are directed to a method of applying the composition of claim 1.

Applicant's election for a single disclosed species of polymer and glycerol, poly(2-hydroxyethyl methacrylate-co-4-hydroxybutyl acrylate) and glyceryl ether, received on 08/14/2007 is acknowledged. Applicant's traversal is on the grounds that a single search with regard to the polymer and glycerol should reveal all of the most relevant art. This is not found persuasive because the species as claimed are patentably distinct, each from the other for the reasons of record as stated in the last office action. Furthermore, the search of the entire groups in the non-patent literature (a significant part of thorough examination) would be burdensome.

Furthermore, applicant's traversal is on the grounds that searching all claims does not impose an undue burden. This is not found persuasive because the inventions and species above are patentably distinct. The search for each of the above inventions/species is not co-extensive particularly with regard to the literature search. Burden consists not only of searching of multiple databases for foreign references and literature searches. Burden also resides in the examination of independent claim sets for clarity, enablement

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and double patenting issues. Further, a reference that would anticipate the invention of one group would not necessarily anticipate or even make obvious another group. Finally, the consideration for patentability is different in each case. Thus, it would be an undue burden to examine all of the above inventions in one application and the restriction requirement is still deemed proper and is therefore made FINAL.

Accordingly, no claims have been amended, cancelled or added.

Claims 1-11, 16 and 17 are presently under examination and are the subject of this office action.

#### *Change of Examiner*

The examiner assigned to the instant application has changed. The new examiner is Anna Pagonakis. Contact information is provided at the end of this Office Action

#### *Information Disclosure Statement*

The information disclosure statement filed on 10/04/2004 has been received. Please see the attached initialed PTO-1449s. Documents with no year of publication provided were not considered.

*Specification*

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The use of trademark Carbowax™ (page 5, last line) has been noted in this application. Trademarks should be capitalized wherever these appear and be accompanied by generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of the designation "HEMA/HBA" renders the claims indefinite as the recitation is too vague. "HEMA/HBA" is a simple acronym/abbreviation that has many different meanings in the art and thus the inclusion thereof renders the claims indefinite.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112 because the claimed preparation of HEMA and HBA is not provided in the instant disclosure. Applicant's disclosure refers Examiner to "US 2002037006," however this document does not exist. Confusingly, a search of the particular number provided indicates the existence of a Japanese document. Applicant is advised that they may have mistakenly cited a Japanese document as a US patent.

Applicant is requested to provide a method of preparation of HEMA and HBA *in English* for further consideration and examination.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the

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various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torgerson et al (US Patent 5,980,878) in view of Okuno et al. (US Patent 6,607,718).

Torgerson et al. teaches a topical skin care composition which is useful for delivering and/or transdermally transporting active ingredients to or through the skin. A hydrophilic copolymer is present "(i) from about 40% to about 90% by weight... [or] (ii) from about 10% to about 60% by weight." (column 2, under summary of invention, paragraph 2). Furthermore, the composition contains emulsifiers with a broad range of viscosities from about 100 cps to about 200,000 cps (column 19, paragraph 5). Also teaches the composition with a cationic polymer and thickener (column 27, paragraph 4). Preferred solvents include water and ethanol (column 18, paragraph 5). The composition may comprise from about 1% to 99% of water (column 20, paragraph 2). Torgerson teaches of a polymer comprising 2-hydroxypropyl acrylate (HBA) and 2-hydroxyethyl methacrylate (HEMA). The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be

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obvious for a person of ordinary skill to determine the optimal amount of each ingredient needed to achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, the optimization of ingredient amounts would have been obvious at the time of applicant's invention.

Okuno et al. teaches of a cosmetic composition suitable for treating hair. Glyceryl ether is included in the composition (see claim 4).

One of ordinary skill in the art would have been motivated to combine the above references and as combined would teach the invention as claimed. One of ordinary skill in the art would have been motivated to combine the teachings of Torgerson et al. with Okuno et al. because both are directed to cosmetic compositions. Moreover, combining agents which are known to be useful as cosmetic compositions individually into a single composition useful for the very same purpose is prima facie obvious. In *Re Kerkhoven* 205 USPQ 1069. Since it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the same purpose, the idea of combining the two references flows logically from having been individually taught in the prior art.

Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolich, Jr et al. (US Patent 5,965,115) in view of Torgerson et al. (US Patent 5,980,878) and Okuno et al. (US Patent 6,607,718).



Bolich Jr., et al teaches personal care compositions which are suitable for application to the hair, skin and nails. Compositions of the invention may contain a variety of other ingredients such as are conventionally used in a given product form. The composition may also be a lipstick (column 14, paragraph 6). The reference also teaches sulfur-linked silicone containing copolymers which are modified with moieties such as fluoroalkyl (column 19-20).

As stated above, Torgerson et al. teaches a topical skin care composition which is useful for delivering and/or transdermally transporting active ingredients to or through the skin. Torgerson's topical skin care composition comprises hydrophilic copolymers in addition to polar solvents (please see previous 103 rejection). Additionally Torgerson teaches the addition of coconut oil (column 24, line 24), clove oil (column 27, line 60), eucalyptus oil (column 27, 61).

Okuno et al. teaches of a cosmetic composition suitable for treating hair. Glyceryl ether is included in the composition (see claim 4).

One of ordinary skill in the art would have been motivated to combine the above references and as combined would teach the invention as claimed. One of ordinary skill in the art would have been motivated to combine the teachings of Bolich Jr, Torgerson et al. with Okuno et al. because both are directed to cosmetic compositions. Moreover, combining agents which are known to be useful as cosmetic compositions individually into a single composition useful for the very same purpose is prima facie obvious. In *Re Kerkhoven* 205 USPQ 1069. Since it is prima facie obvious to combine three

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compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a fourth composition to be used for the same purpose, the idea of combining the three references flows logically from having been individually taught in the prior art.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anna Pagonakis whose telephone number is 571-270-3505. The examiner can normally be reached on Monday thru Thursday, 9am to 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
ARDIN H. MARSCHEL  
SUPERVISORY PATENT EXAMINER

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